

App. No. 09/489,601
Amendment D
Page 6

REMARKS

Applicants have amended claims 1, 6 and 11. Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested. Fifteen claims are pending in the application: claims 1-15.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Thomas F. Lebens at (805) 781-2865 so that such issues may be resolved as expeditiously as possible.

35 U.S.C. § 103

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,825,876 (Peterson) in view of U.S. Patent Application Publication No. 2002/0026321 (Faris et al.). Applicants have amended independent claims 1, 6 and 11, and respectfully submit that the combination of references fails to teach or suggest all of the claim limitations of amended claims 1, 6 and 11.

More specifically, claim 1 for example, recites in part:

- (a) providing a plurality of events stored in memory on a plurality of client apparatuses, the events each having a unique identifier identifying the event stored in memory associated therewith and stored in the memory, wherein the client apparatuses are adapted to be coupled to a host computer via a network;
- (b) ascertaining whether the client apparatuses have the event stored in memory comprising ascertaining the identifier of the event stored in the memory of the client apparatuses utilizing the network;
- (c) comparing the identifier of the event stored in the memory with an identifier of a scheduled event; and
- (d) beginning the playback of the event simultaneously on each of the client apparatuses upon ascertaining that the client apparatus has the predefined content stored and that the comparison renders a match.

Neither the Peterson patent nor the Faris reference teach or suggest at least "ascertaining whether the client apparatuses have the event stored in memory" or the "beginning the playback of the event simultaneously on each of the client apparatuses upon ascertaining that the client apparatus

App. No. 09/489,601
Amendment D
Page 7

has the predefined content stored and that the comparison renders a match.” Alternatively, the Peterson patent specifically teaches away from ascertaining whether the client apparatus stores an event by comparing an “identifier of the event stored in memory” in the client apparatuses because the Peterson reference already knows that the client already has the event.

Further, the Peterson patent teaches away from “beginning the playback of the event simultaneously on each of the client apparatuses upon ascertaining that the client apparatus has the predefined content stored and that the comparison renders a match” because the Peterson patent specifically defines a window of time within which the user can start playback. To alter the Peterson patent to initiate playback at the time the comparison of the identifier of the event stored in the memory and the identifier of the scheduled event renders a match, as this would make the Peterson patent ineffective for its intended use of providing a window of time from which the user can select to view the content.

Section 2143.01 of the MPEP states, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or motivation to make the proposed modification. It is clear that the Peterson patent intends to establish a window of time. To combine the Peterson patent with the Faris reference would render the Peterson patent unsatisfactory for its intended purpose. Therefore, there is no motivation to combine.

The Examiner, on page 4 of the Advisory Action, suggested that there is nothing in the claim that ascertaining the identifier of the event utilizing the network has temporal relationship to the even being stored in memory. However, Applicants respectfully submit that the temporal relationship is defined at least in part by the beginning playback “simultaneously on each of the client apparatuses.” The Peterson patent specifically teaches away from this operation in that the Peterson patent established a window of time within which users can activate. Therefore, the Peterson patent teaches away from the method as claimed.

The Faris reference also teaches away from at least the ascertaining of whether the client device stores the content, as the Faris system already knows the system has the content. Still further, the Faris reference does not teach or suggest initiating playback upon ascertaining

App. No. 09/489,601
Amendment D
Page 8

that the client device contains the content, and the comparison of the identifier of the event stored in the memory and the identifier of the scheduled event renders a match. Alternatively, the Faris reference only describes comparing timing. The timing is not an “identifier of the event stored” as claimed. Therefore, the combination of the Paterson and Faris references does not teach each element as claimed.

Section 2143.03 of the MPEP states that in order “to establish a prima facie case of obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art.” Therefore, a prima facie case of obviousness is not met by the combination of the Peterson and Rice references as the combination does not teach or suggest all of the limitations of claim 1 (MPEP § 2143.03). Thus, Applicants respectfully submit the rejection is overcome and should be withdrawn.

Independent claims 6 and 11 have been amended to include language similar to that of claim 1. Therefore, claims 6 and 11 are also not obvious over the combination of references for at least the reasons provided above.

Further, claims 2-5, 7-10 and 12-15 depend from amended claims 1, 6 and 11, respectively. Therefore, claims 2-5, 7-10 and 12-15 are also not obvious in view of the applied references for at least the reasons provided above.

Response To Advisory Action

The Examiner issued an Advisory Action, mailed February 8, 2005 in reply to Applicants’ prior Response submitted December 20, 2004. In the Advisory Action the Examiner maintains the opinion that previous claims 1-15 were obvious. The Examiner argues initially in response to Applicants’ contention that Peterson teaches away from beginning playback upon confirmation of a match stating “nowhere within Peterson does the reference explicitly teach away from Peterson. Merely playing back material without the use of identifiers is not teaching away from the combination of Peterson and Faris.” Applicants are confused by the Examiners reference to Peterson twice and further respectfully submit that the Examiner has misrepresented

App. No. 09/489,601
Amendment D
Page 9

Applicants argument. Specifically, Applicants submit that the intended purpose of the Peterson patent is to establish a window of time within which a user can initiate access to content. To eliminate this window of time within which the user can initiate access to content would defeat the intended purpose of the Peterson patent. Therefore, one skilled in the art would not combine the simultaneous playback of Faris with Peterson as this would eliminate the intended purpose of the Peterson patent in providing the window of time within which the user can initiate access. Therefore, there one skilled in the art would not be motivated to combine Faris with Peterson. The Examiner suggests on page 4 of the Advisory Action that the Faris reference provides the motivation to combine. However, the combining would defeat the intended purpose of Peterson to provide a window of time during which a user can view content, thus rendering the Peterson patent unsatisfactory for its intended use (MPEP §2103.01). Therefore, there is no motivation to combine as such combination would be detrimental to the system of Peterson.

The Examiner then continues arguing that the Faris reference does compare identifiers stating that Faris "inherently has some form of identifiers in order to indicate the time." (Advisory Action, page 2, lines 21-22, emphasis added). However, Applicants respectfully submit that the claims did not and do not recite simply any "identifier", but instead specifically recite "identifier of the event stored in the memory" and "identifier of a scheduled event". (Emphasis added). The Examiner's reference to inherent "identifiers in order to indicate the time" cannot be equated to Applicants' claimed "identifier of the event stored in the memory" because the Applicants do not claim just identifiers, but instead recite "identifier of the event stored in the memory", and equate "identifiers in order to indicate the time" to claimed identifiers would effectively remove claim language from the claim. Therefore, the Faris reference does not teach or suggest the comparing an identifier of the event stored in memory with an identifier of a scheduled event as claimed.

The Examiner continues on pages 2-3 to state "clearly, there is a comparison of the received identifier of Peterson (e.g., common premier time), with the time in order to launch" (Advisory Action, emphasis added). Again, Applicants' respectfully submit that the claims do not recite an identifier of time, but instead recite "identifier of the event stored in the

App. No. 09/489,601
Amendment D
Page 10

memory” and “identifier of a scheduled event”. These identifiers cannot be equated to a time reference and to do so effectively eliminates language from the claims. Therefore, Applicants respectfully submit that combination of references fail to make the claims obvious.

The Examiner then rebuts Applicants’ arguments stating “Faris teaches matching identifiers, which are inherent to the GPS/NTP signals, which display time of an event.” (Advisory Action, page 3, lines 4-6, emphasis added). Again, Applicants submit that the claims do not recite identifier, but instead recite “identifier of the event stored in the memory” and “identifier of a scheduled event” that cannot be equated to “time.” Therefore, the combination of references does not make the claims obvious.

The Examiner continues disagreeing with Applicants argument that the Peterson patent does not suggest “ascertaining the identifier of the event stored in the memory of the client apparatuses utilizing the network” as recited, for example in claim 1, suggesting that Peterson teaches receiving programming and storing the event in memory and that an identifier inherently exist. However, Applicants again submit that the claims do not recite receiving programming. Instead, the claim provides that by using a network an identifier is ascertained.

The Examiner then suggests on page 4 of the Advisory Action that claim 1 does not have a temporal relationship to the event being stored in memory. However, Applicants respectfully submit that the temporal relationship is defined at least in part by the beginning playback “simultaneously on each of the client apparatuses” and in the “beginning the playback of the event simultaneously on each of the client apparatuses upon ascertaining that the client apparatus has the predefined content stored and that the comparison renders a match.” Therefore, claim 1 provides a temporal relationship that is not taught by either of the cited references.

The Examiner then addresses Applicants’ arguments that a start “time” is not equivalent to the identifier as claimed stating “there is nothing in the claims describing the scope of the identifier.” (Advisory Action, page 4, lines 14-15). Applicants, however, direct the Examiner to the language of claim 1 reciting “identifier of the event stored in the memory of the client apparatuses”. Applicants do not understand how the scope of the “identifier” is not described, when the scope is clearly labeled as an identifier of the event stored in the memory of

App. No. 09/489,601

Amendment D

Page 11

the client apparatuses. Therefore, the start "time" suggested by the Examiner cannot be equated to an identifier of the stored event because the start "time" is simply a time, and nowhere does the Faris reference suggest that the start "time" is an identifier.

The Examiner then addresses Applicants argument that there is no motivation to combine Peterson with Faris stating "the secondary reference, Faris teaches modifying the window of time of Peterson to a time instance to require simultaneous access to content." (Advisory Action, page 5, lines 1-2). However, the Examiner failed to address the fact that altering the Peterson reference to require simultaneous playback would defeat the intended purpose of the Peterson patent, which intentionally provides a window of time so that users can access content at their convenience, thus rendering the Peterson patent unsatisfactory for its intended use (MPEP §2103.01). One skilled in the art would not combine Faris with Peterson because to do so with be detrimental to the intended purpose of Peterson. Therefore, there is no motivation to combine as such combination would be detrimental to the system of Peterson.

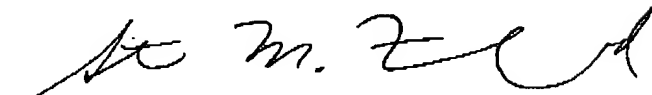
Therefore, Applicants respectfully submit that one skilled in the art would not combine the Peterson patent with the Faris reference, and that the combination fails to establish a prima facie case of obvious as the combination does not teach the elements as claimed, and that there is no motivation to combine the references. Thus, claims 1-15 were not obvious over the applied references, and amended claims 1, 6, and 11 are clearly not obvious over the combination of Peterson and Faris.

App. No. 09/489,601
Amendment D
Page 12

CONCLUSION

In view of the above amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Therefore, Applicants respectfully request favorable action.

Respectfully submitted,



Steven M. Freeland
Reg. No. 42,555

Dated: March 21, 2005

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 South LaSalle Street, Ste. 1600
Chicago, IL 60603
(858) 552-1311

68624amd
410373_1